EXHIBIT A

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UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

TRIANTAFYLLOS TAFAS, Plaintiff, v. JON W. DUDAS, in his official capacity as Under Secretary of Commerce and Director of the United States Patent and Trademark Office and The UNITED STATES PATENT AND TRADEMARK OFFICE, Defendants.	)	CIVIL ACTION NO. 1:07cv846

MEMORANDUM IN SUPPORT OF DEFENDANTS' PARTIAL MOTION TO DISMISS

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rules that do not threaten any actual concrete interest.

Finally, the USPTO seeks dismissal of all of Plaintiff's constitutional claims in Count Two for failure to state a claim. *See* Fed. R. Civ. P. 12(b)(6). As explained below, the USPTO could not have violated the "Patent and Copyright Clause" of the Constitution, U.S. Const. art. I, § 8, cl. 8, for numerous reasons. The USPTO also could not have violated the Fifth Amendment because Plaintiff has no cognizable property interest. The Court should thus dismiss Count Two for failure to state a claim upon which relief may be granted.[3]

BACKGROUND

I. Patent Application Process

An inventor who seeks to protect an invention may file a patent application with the USPTO. The first application the inventor files for a given invention is known as the "**parent**" (or "initial") application. A patent application is, essentially, a draft patent. It contains two primary parts: (1) a "**specification**"; and (2) one or more "**claims.**" The specification describes the invention for which a patent is sought as well as how to make and use the invention. See 35 U.S.C. § 112, first paragraph. The claims identify what the applicant regards as his invention, i.e., the scope of legal protection the applicant believes his or her invention is entitled to receive. See id., second paragraph; In re Vamco Mach. & Tool, Inc., 752 F.2d 1564, 1577 n.5 (Fed. Cir. 1985) ("[C]laims are not technical descriptions of the disclosed inventions but are legal documents like the descriptions of lands by metes and bounds in a deed").

A patent claim may be in "**independent**" or "**dependent**" form. An independent claim, as the name suggests, stands on its own, reciting all the limitations of the invention. See 35

[3] To the extent the Court grants the USPTO's Partial Motion to Dismiss, the claims remaining for summary judgment would be: Paragraph 56(i) of Count One; Paragraph 68 and Paragraphs 71(a), (b), (d), (g), (h), and (i) of Count Three; and Count Four.

U.S.C. § 112, third paragraph. By contrast, a dependent claim incorporates the limitations of the independent claim and recites one or more further limitations of the invention. See id., fourth paragraph. Similar to a dependent claim, a **"multiple dependent claim"** incorporates the limitations of two or more claims in the alternative and recites one or more further limitations.[4] See id., fifth paragraph; see also U.S. Pat. & Trademark Off., Manual of Patent Examining Procedure ("MPEP") § 608.01(n) (8th ed. 2001, rev. Aug. 2006).

When a patent applicant files an application with the USPTO, a patent examiner determines whether the claimed invention meets the statutory requirements found in Title 35 of the United States Code. See 35 U.S.C. §§ 101, 102, 103 & 112. If the examiner finds that a claim does not comply with the statutory patentability requirements, the examiner will reject the claim and issue an **"Office action"** setting forth the reasons for the rejection. 35 U.S.C. § 132(a); 37 C.F.R. § 1.104(a) (2006). In response, the applicant may (i) amend the claims; (ii) argue against the rejection; or (iii) present evidence to show why the claimed invention is believed to be patentable. 37 C.F.R. § 1.111 (2006). The examiner may then "allow"—that is, authorize for patenting—some or all of the claims or issue another rejection. The back-and-forth exchange that occurs between an applicant and an examiner is commonly referred to as the **"prosecution"** of an application.

Upon receipt of a final rejection, an applicant has three choices: (1) appeal to the Board of Patent Appeals and Interferences ("Board") and from there to the Federal Circuit, 35 U.S.C.

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[4] For example, Claims 1 and 2 below are independent claims; Claim 3 is a dependent claim; and Claim 4 is a multiple dependent claim.

1. An automobile comprising: a chassis; an engine; and four wheels.
2. An automobile comprising: a chassis; an engine; four wheels; and four doors.
3. The automobile of claim 1 wherein the engine is an internal-combustion engine.
4. The automobile of claims 1 or 2 wherein the engine has eight cylinders.

§§ 134, 141; (2) file a **"request for continued examination"** of the application, which typically extends examination of the application for two more rounds with the examiner, 35 U.S.C. § 132(b); 37 C.F.R. § 1.114 (2006); or (3) file a **"continuation"** or a **"continuation-in-part"** application of the initial application.[5]

An applicant files a "continuation" application when the applicant wants to amend the claims, offer additional evidence on patentability, or further argue why the claims are patentable. A continuation uses the same specification as the pending parent application, must name at least one of the same inventors as the parent application, and enjoys the benefit of the filing date (a.k.a. **"priority date"**) of the parent application. See 35 U.S.C. § 120; MPEP § 201.07.

A continuation-in-part application is similar to a continuation application in that it repeats some portion of the specification of the parent application. The difference is that it includes additional new subject matter that was not disclosed or claimed in the parent application. Claims drawn to the repeated subject matter in a continuation-in-part application are entitled to the benefit of the filing date of the parent application, but claims drawn to new subject matter are entitled to the benefit of only the new filing date. See 35 U.S.C. § 120; MPEP § 201.08.

Sometimes, an applicant may disclose and claim more than one independent or distinct invention in the initial application. In such cases, an examiner may require the applicant to separate the multiple independent or distinct inventions into one or more **"divisional"** applications,[6] each claiming only a single invention. See 35 U.S.C. § 121. This is called a

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[5] The applicant need not await a final rejection to file a continuation or continuation-in-part application. As discussed infra, Plaintiff himself has filed four continuation-in-part applications off of his parent application, even though he has not received a final rejection of his parent application.

[6] Plaintiff uses the terms "voluntary-divisional continuation patent application" or a "voluntary divisional" throughout the Amended Complaint. When he does so, Plaintiff is referring to a continuation or continuation-in-part application and not an application filed

"restriction requirement." In response to a restriction requirement, the applicant must choose one of his or her claimed inventions to prosecute in the initial application and is authorized to file separate "divisional" applications to protect each of other inventions. Like a continuation application, a divisional application claims the priority date of the parent application.[7] See id.; MPEP § 201.06.

By statute, a patent application must be published eighteen months from the earliest effective filing date of the application—that is, the filing date of the earliest application to which the application claims priority. See 35 U.S.C. § 122(b)(1); 37 C.F.R. § 1.211 (2006). An applicant can, however, prevent his or her application from publishing by filing a non-publication request. See 35 U.S.C. § 122(b)(2)(B)(i); 37 C.F.R. § 1.213 (2006). If the applicant agrees not to file his or her application in a foreign country that publishes applications, the USPTO must maintain the application in confidence until a patent issues.

After an application issues as a patent, a patentee may realize that he or she claimed more or less than he or she had a right to claim or that the patent is inoperative or invalid due to an unintentional error. The patentee may surrender the patent to the USPTO and file a **"reissue application"** to correct the error. See 35 U.S.C. § 251. A "reissue application" is examined like

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pursuant to a restriction requirement under 35 U.S.C. § 121. As explained in the Manual of Patent Examining Procedure, a "divisional" application under 35 U.S.C. § 121 can be filed only if a restriction requirement has first been issued. See MPEP § 804.01 ("The 35 U.S.C. 121 [entitled "Divisional Applications"] prohibition applies only where the Office has made a requirement for restriction. The prohibition does not apply where the divisional application was voluntarily filed by the applicant and not in response to an Office requirement for restriction." (emphasis added)). The term "voluntary divisional" is not based in Title 35, the corresponding regulations, or agency guidance; instead, it is a term loosely used by patent applicants and practitioners in referring to a filing that is really a continuation application. See Ex. 3, Young Decl. ¶ 33. To be clear, Plaintiff's use of the term "voluntary divisional" is misleading; "continuation" or "continuation-in-part" is the correct term.

[7] Collectively, a "continuation," a "continuation-in-part," and a "divisional" are commonly referred to as **"continuing applications."** See 37 C.F.R. § 1.53(b) (2006).

any other application. See 37 C.F.R. § 1.176 (2006); MPEP § 1440.

In some cases, the federal government may support research and development efforts to bring forth new inventions and may have patent rights in inventions made with federal assistance. See 35 U.S.C. §§ 200, 203. If so, then the federal agency may, under some circumstances, exercise **"march-in rights"** and require the contractor who invented the invention or the assignee or exclusive licensee of the invention to grant a license to the invention. See id. § 203.

II. HISTORY OF THE FINAL RULES FOR CONTINUATION AND CLAIMS PRACTICE

Over the past decade, the growing number of continuing applications, as well as the increasing number and complexity of claims in patent applications, have crippled the Office's ability to examine newly-filed applications.[8] See Changes To Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications; Final Rule, 72 Fed. Reg. No. 46716, 46718 (Aug. 21, 2007) (Ex. 2) ("Final Rules"). Consequently, in January of 2006, the USPTO proposed new rules for filing continuing applications and for presenting claims. See Changes to Practice for Continuing Applications, Requests for Continuing Applications, Requests for Continued Examination Practice, and Applications Concerning Patentably Indistinct Claims, 71 Fed. Reg. 48-61 (Jan. 3, 2006); Changes to Practice for the Examination of Claims in Patent Applications, 71 Fed. Reg. 61-69 (Jan. 3, 2006) (collectively "Proposed Rules") (Ex. 3). The USPTO solicited public comments to the Proposed Rules and provided a four month comment period. Id. at

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[8] The growing number of continuing applications are attributable to a variety of factors, including: (1) applicants filing deficient initial applications and relying on the availability of an endless stream of continuing applications to work out issues of patentability; (2) applicants using the availability of continuing applications to delay the conclusion of examination so as to buy time to figure out what their commercially viable invention is or to monitor marketplace developments for similar inventions which may fall within the scope of yet-to-be-presented claims; (3) applicants filing literal or machine-translated documents as patent applications and using continuing applications to correct avoidable mistakes. See Ex. 2 at 46719.